REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-5, 7-24, 26-43, and 45-78 are presently active in this case, Claims 1, 8, 16, 17, 19, 20, 27, 35, 36, 38, 39, 46, 54, 55, 57, 58, 61, 62, 65, 68, 69, 72, 75, and 76 having been amended by way of the present Amendment.

In the outstanding Official Action, Claims 1-4, 7-12, 15-18, 20-23, 26-31, 34-37, 39-42, 45-50, 53-56, 58-63, 65-70, and 72-77 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. (U.S. Patent No. 6,141,753) in view of Navarre et al. (U.S. Patent No. 6,442,611). Claims 5, 24, 43, 64, 71, and 78 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. in view of Navarre et al. and further in view of Houser et al. (U.S. Patent No. 5,606,609). Claims 13, 14, 32, 33, 51, and 52 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. in view of Navarre et al. and further in view items upon which Official Notice has been taken. Claims 19, 38, and 57 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. in view of Navarre et al. and further in view of Stefik et al. (U.S. Patent No. 6,233,684). For the reasons discussed below, the Applicants request the withdrawal of the art rejections.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or

suggest all of the claim limitations. The Applicant submits that a *prima facie* case of

obviousness cannot be established in the present case because the reference, either taken

singularly or in combination, do not teach or suggest all of the claim limitations.

Claim 1 of the present application recites a method for managing documents,

comprising, among other steps, the step of sending a merge command to a printing entity

requesting that a document be printed with watermark information received from the printing

entity. Claim 20 recites a system for managing documents comprising, among other features,

means for sending a merge command to a printing entity requesting that a document be

printed with watermark information received from the printing entity. And Claim 39 recites a

computer program product comprising, among other features, a fifth computer code device

configured to send a merge command to a printing entity requesting that a document be

printed with watermark information received from the printing entity. Claim 58 of the

present application recites a method for managing documents comprising, among other steps,

the steps of merging the document with watermark information received from a printing

entity, and transmitting the document merged with the watermark information to the printing

entity. Claim 65 recites a system for managing documents comprising, among other features,

means for merging the document with watermark information received from a printing entity,

and means for transmitting the document merged with the watermark information to the

printing entity. Claim 72 recites a computer program product comprising, among other

features, a fourth computer code device configured to merge the document with watermark

information received from a printing entity, and a fifth computer code device configured to

transmit the document merged with the watermark information to the printing entity.

The Applicants respectfully submit that the cited references, either taken singularly or in combination, fail to teach sending a merge command to a printing entity requesting that a document be printed with watermark information received from the printing entity, or merging a document with watermark information received from a printing entity and transmitting the document merged with the watermark information to the printing entity. Thus, the Applicants submit that the cited references fail to establish a prima facie case of obviousness with respect to Claims 1, 20, 39, 58, 65, and 72 of the present application.

The present application describes a non-limiting embodiment of the invention on page 18, lines 8-13, in which watermark information is received from the printing entity. For example, the application notes that the information can be the printer's serial number, the location of the printer, and/or the time and date to be printed to a printing engine. The cited references do not disclose such a feature.

The Zhao et al. reference describes a technique for the secure distribution of digital representations that combine encryption and watermarking. The Zhao et al. reference makes brief mention of the use of printers, however, the Zhao et al. reference does not disclose or even suggest the receipt of watermark information from the printer itself. The Zhao et al. reference describes the use of secret fingerprint watermarks that identify the user and can be used to verify whether the user has the authority to utilize the information in the manner being attempted by the user. The Zhao et al. reference does not disclose a merge command to a printing entity requesting that a document be printed with watermark information received from the printing entity, or merging a document with watermark information received from a printing entity and transmitting the document merged with the watermark information to the

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printing entity, as recited in Claims 1, 20, 39, 58, 65, and 72 of the present application.

The Applicants submit that the Navarre et al. reference fails to supplement the deficiency in the Zhao et al. reference discussed above. The Navarre et al. reference describes a system and method for executing a request from a client application where the client application sends a single request to a gateway application, which converts the request into appropriate data access transactions. The client application is presented with a single integrated response.

The Navarre et al. does not discuss watermarks or the printing of the document. Thus, the Navarre et al. reference clearly does not disclose or even suggest the receipt of watermark information from a printing entity.

Since neither the Zhao et al. reference nor the Navarre et al. reference disclose a merge command to a printing entity requesting that a document be printed with watermark information received from the printing entity, or merging a document with watermark information received from a printing entity and transmitting the document merged with the watermark information to the printing entity, the proposed combination of these references does not render Claims 1, 20, 39, 58, 65, and 72 of the present application obvious. Thus, the Applicants respectfully request the withdrawal of the obviousness rejections of Claims 1, 20, 39, 58, 65, and 72.

The dependent claims are considered allowable for the reasons advanced for the independent claims from which they depend. The dependent claims are further considered allowable as they recite other features of the invention that are neither disclosed nor
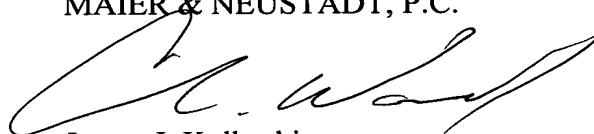
suggested by the applied references when those features are considered within the context of

the respective independent claim.

Consequently, in view of the above discussion, it is respectfully submitted that the

present application is in condition for formal allowance and an early and favorable

reconsideration of this application is therefore requested.

Respectfully Submitted,

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